

REMARKS

These remarks, submitted in response to the Office Action dated January 12, 2007 is believed to be fully responsive to each point of objection raised therein. Accordingly, favorable reconsideration is respectfully requested.

Claims 1-27 are all the claims pending in the application. Claims 1-27 are rejected.

Claims 1- 2 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mills (US Pat. No. 5,237,648, hereinafter “Mills”) in view of Koyata (US Pat. No. 6,462,753, hereinafter “Koyata”). Applicant respectfully traverses the rejections as follows.

The combination of Mills and Koyata fails to teach or suggest each feature of claim 1. For example, claim 1 recites building a list of starting and ending marks for each selected portion of first content stored in a first format in a first storage medium. The list is for use in accessing corresponding portions of the same content stored as second content in a second format. The claim further recites that the second storage medium is a slower access storage medium than the first storage medium.

Neither Mills nor Koyata, alone or in combination, teach these features. The detailed descriptions of Mills and Koyata can be found at least at pages 2 and 3 of the November 9, 2006 Amendment.

The Examiner correctly concludes that Mills does not teach or suggest that the claimed first and second storage medium in which the second storage medium is a slower access storage medium than the first storage medium. See final Office Action p. 3. The Examiner cites Koyata for teaching “first and second storage medium where the second storage medium stores edited

programs.” As the Examiner admits at page 4 of the final Office Action, Koyata is directed to a user dragging and dropping selected programs to be recoded on a mini-disc (MD) or other type of medium, such as a magnetic tape, DVD, CD-R, etc. In the final Office Action it is asserted that based on Koyata, it would have been obvious “to record the second content to the second recording medium in order to record the desired content in the second recording medium.” See p. 4. In the final Office Action it is also asserted that “The cited reference of Mills is combined with Koyata to show that it is obvious to receive frames from one storage medium which has a predetermined storage access, edit the received frames, and store them into a different storage medium which has slower access than the first storage medium.”

Applicant respectfully submits that even if Mills were modified based on Koyata, as asserted in the final Office Action, to store edited frames into a different storage medium which has slower access, the combination would not satisfy claim 1. Claim 1 recites building a list that is used for “accessing corresponding portions of the same content stored as second content in a second format,” (emphasis added), in which the second storage medium is a slower access medium than the first storage medium. The claim does not recite using the list for recording onto a second storage medium as asserted in the final Office Action. Accordingly, the asserted combination does not render claim 1 unpatentable.

Claims 2 and 8 are patentable at least because of their dependency from claim 1.

Claims 3-7, 11-15, and 19-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mills in view of Koyata and further in view of Fujita (US Pat. No. 6,321,024, hereinafter “Fujita”).

Claims 3-7 are patentable at least because of their dependency from claim 1 and because Fujita does not remedy the deficiencies of Mills and Koyata with respect to claim 1. Claims 11-15 and 19-23, which include similar features to those of claim 1 discussed above, are patentable at least for the reasons analogous to these provided for claim 1 and because Fujita does not remedy the deficiencies of Mills and Koyata with respect to claim 1.

Claims 9, 10, 16-18 and 24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mills in view of Koyata and further in view of alleged Official Notice that it is well known in the art to embody inventions in software to be executed by computer.

Claims 9, 10, 16-18 and 24, which recite similar features to those of claim 1 discussed above, are patentable at least for the reasons analogous to those provided for claim 1 and because the alleged Official Notice does not remedy the deficiencies of Mills and Koyata with respect to claim 1.

Claims 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mills in view of Koyata and further in view of Langford (US Pat. No. 5,206,929, hereinafter “Langford”).

Claim 25 is patentable at least because of its dependency from claim 1 and because Langford does not remedy the deficiencies of Mills and Koyata with respect to claim 1.

Claims 26 and 27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mills in view of Koyata and further in view of alleged Official Notice and further in view of Langford. The Examiner does not specify the alleged Official Notice. Applicants infer from the obviousness rejections of the respective base claims of claims 26 and 27, *i.e.* claims 9 and 17,

that the Examiner takes the alleged Official Notice that it is well known in the art to embody inventions in software to be executed by computer.

Claims 26 and 27, which recite limitations similar to those of claim 1 discussed above, are patentable at least for the reasons analogous to these provided for claim 1 and because the alleged Official Notice and Langford do not remedy the deficiencies of Mills and Koyata with respect to claim 1.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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